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| APPLICATION NO.                                   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/614,010  | 07/08/2003  | Carmelo Lo Duca      | 239936US6           | 9524             |
| 22850   | 7590        | 11/19/2004           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. |             |                      | GEHMAN, BRYON P     |                  |
| 1940 DUKE STREET                                  |             |                      | ART UNIT            |                  |
| ALEXANDRIA, VA 22314                              |             |                      | PAPER NUMBER        |                  |
|   |             |                      | 3728                |                  |

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/614,010

Applicant(s)

LO DUCA, CARMELO

Examiner

Bryon P. Gehman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/15/03, 1/29/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, lines 4-5, "lids or panels" is indefinitely alternative, as the alternative is between two mere nomenclatures or between two different scopes of the structure. A lid is not structurally the same as a panel, as a lid is a panel, but a panel is not necessarily a lid. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "panels", and the claim also recites "lids" which is the narrower statement of the range/limitation. Similarly, in line 7, the difference between "crease lines" and "folding lines" or scope covered thereby is indefinite. Folding lines

are crease lines, but not all crease lines are folding lines. In line 9, "plurality or succession" are also of different scope, as "plurality" does not distinguish any order, while "succession" does: See also claim 3, line 3, where "windows or apertures" is also different in scope, not all apertures being windows.

Also in claim 1, line 5, "the two ends of the box" lacks antecedent basis.

In claim 2, lines 2-3, "at least two of which" is indefinite which antecedent is being referred to. In lines 3-4, "one of the inner walls" lacks clear antecedent basis for the term "inner wall". See also claims 5 and 6, lines 3 and 4. In line 4, "an outer wall" is indefinite as to its relation to the previously defined outer walls. In line 8, "outer main walls" is inconsistent with the previous terminology, "outer walls, as is "inner main walls" of line 9.

In claims 3 and 4, lines 2 and 4 of each, it is indefinite whether "crease lines" refers to only crease lines or also folding line as originally set forth in claim 1, line 7.

In claims 5, 6 and 7, line 3 of each, it is indefinite whether "crease lines" refers to only crease lines or also folding lines as originally set forth in claim 1, line 7. In line 6, "the first stated inner wall" is indefinite, as inner walls are first defined in claim 2. The phraseology should be --the said one inner wall--.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. It is unclear what is delimited by "the above specified characteristics".

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberg Jr. (3,575,286). Claims 1 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by EP 1219542. Each discloses a box of quadrangular cross-section comprising a plurality of consecutive main walls (22-21-20-14-12-13-15-16; 5-1-2-3-4-12A-12B; respectively) separated from each other by parallel longitudinal folding lines and one main wall (15 or 16 or 21 or 22) glued to the inside of another main wall (21 or 12 or 20 or 12) and also comprising two panels (25 and 26) for closing ends of the box, wherein along the longitudinal folding lines are provided a plurality of separate aligned cuts (b; 15 or 16).

As to claim 8, each discloses a punched and crease-lined sheet.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lightner et al. (3,147,856) in view of either one of Rosenberg Jr. and EP 1219542. Lightner et al. discloses a box of quadrangular cross-section comprising a plurality of consecutive main walls (12-19) separated from each other by parallel longitudinal folding lines and one main wall (12) glued to the inside of another main wall (15) and also comprising two panels (32 and 35) for closing ends of the box. Rosenberg Jr. and EP 1219542 disclose similar boxes wherein along longitudinal folding lines are provided a plurality of separate aligned cuts (b; 15 or 16). To modify the box of Lightner et al. employing the cut teaching of either one of Rosenberg Jr. and EP 1219542 would have been obvious in order to facilitate folding of the crease lines.

As to claim 2, Lightner et al. discloses the main walls as at least six in number, of which four (15-18) form the outer walls of the box, at least two of the main walls (12-14) folded into the box interior to form inner walls, one of the inner walls (12) being glued to one of the outer walls and one other inner wall (13) being spaced from that outer wall to form a pocket inherently capable of housing an illustrative leaflet (coupon).

As to claims 3 and 4, the cuts of Rosenberg Jr. and EP 1219542 are apertures and displaced longitudinally along the crease lines.

As to claims 5-7, Lightner et al. disclose three inner walls (12-14), one wall (12) spaced from a facing outer wall (16) with the other two inner walls (13-14) resting

against the outer walls (17-18). Rosenberg Jr. and EP 1219542 each disclose gluing an inner wall (21; 4) to an outer wall (20; 5).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are analogous boxes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4555.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Bryon P. Gehman". The signature is fluid and cursive, with a long horizontal stroke at the end.

Bryon P. Gehman  
Primary Examiner  
Art Unit 3728

BPG